

REMARKS

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided. Applicant also notes with appreciation Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application by the return of the initialed and signed PTO-1449 forms and the Examiner's acknowledgment of Applicant's claim for priority and receipt of the certified copies of the priority documents in the Official Action.

Upon entry of the present Amendment, claim 1 will have been amended to correct a clerical error therein (*i.e.*, by changing "lens group" to ---optical element---) and claims 12-22 will have been added. Claims 1-22 are pending for consideration by the Examiner. Applicant notes that newly-added claims 12-22 generally correspond to original claims 1-11, and recite, *inter alia*, a digital camera having an image pickup device and a body.

Turning to the merits of the action, the Examiner has rejected claims 1-11 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 4,937,609 to WAKABAYASHI, finding that this reference teaches all limitations of these claims.

Applicant respectfully traverses the Examiner's rejection. Applicant submits that WAKABAYASHI, as well as the other references of record, are markedly different from the present claimed invention. For example, with respect to independent claim 1, WAKABAYASHI fails to teach or suggest at least the claimed feature that at least the first optical element and the second optical element are movable *independently* in the optical axis direction (emphasis added). Rather, WAKABAYASHI is directed to a bifocal camera (*i.e.*, a camera having only two focal lengths). Specifically, Fig. 3 of WAKABAYASHI shows main

lens 60 (considered to be the first optical element by the Examiner) and sub lens 70 (considered to be the third optical element by the Examiner) positioned along an optical axis in a TELEPHOTO position (*see* col. 5, lines 47-49), with the soft focus filter 80 (considered to be the second optical element by the Examiner) removed from the optical axis. Fig. 4 of WAKABAYASHI shows the main lens 60 and soft focus filter 80 positioned along the optical axis in a WIDE-ANGLE position, with the sub lens 70 removed from the optical axis (*see* col. 5, lines 50-53). As such, the distances between the optical elements is constant.

Applicant notes that WAKABAYASHI, at col. 5, lines 21-24, indicates that “[t]he present invention is also applicable to a camera having a variable focal length lens such as a zoom lens in addition to a camera whose focal lengths are stepwisely changed.” However, this discussion of a zooming function is only in passing, and the patent is totally silent as to any enabling explanation of how the disclosed structure of WAKABAYASHI may be used to perform a zooming operation. Nor is there any discussion or recognition in WAKABAYASHI of how a zoom lens could be different from that described in the specification.

Also with respect to claim 1, Applicant notes that WAKABAYASHI fails to teach or suggest the claimed limitation that when the retractable lens moves from the ready state to a retracted state, the third optical element is positioned in the ring-shaped portion while the first optical element is retracted from an on-axis position on the optical axis into an off-axis space radially outside the ring-shaped portion such that the first optical element is positioned radially outside the second optical element and the third optical element. For example, as discussed above, the Examiner has compared the main lens 60 of WAKABAYASHI with the first optical element; however, the main lens 60 is not positionable to an off-axis space. To the contrary, the

P23704.A03

main lens 60 of WAKABAYASHI is always positioned on the optical axis. Even if the Examiner was to equate the sub lens 70 or soft focus filter 80 of WAKABAYASHI to the claimed first optical element, then there would be no corresponding third optical element.

It is therefore respectfully submitted that WAKABAYASHI, as well as the other references of record, fails to teach or suggest the invention of independent claim 1 (or of newly-added independent claim 12), as well as the claims dependent therefrom.

With respect to the Examiner's rejection of dependent claims 2-11, since these claims are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed supra, these dependent claims are also allowable for at least these reasons. Further, all dependent claims (including newly-added dependent claims 13-22) recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Absent a disclosure in a single reference of each and every element recited in a claim, a prima facie case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1, and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102(b).

The Examiner has rejected claims 1-11 under 35 U.S.C. § 102(e) as being anticipated by US Patent Publication No. 2003/0156832 A1 to NOMURA et al. (in which present Inventor Nomura is an inventor), finding that this reference teaches all of the limitations of the above claims.

P23704.A03

Applicant respectfully traverses the Examiner's rejection and notes that the NOMURA et al. publication is not prior art under 35 U.S.C. § 102. Specifically, Applicant notes that the two Japanese priority patent applications (*i.e.*, Japanese Patent Application Nos. 2002-247338, filed August 27, 2002; and 2003-25417, filed February 3, 2003) each have Japanese filing dates that are before the February 20, 2003 U.S. filing date of the NOMURA et al. publication. In this regard, and in order to expedite the allowance of the present application, Applicant submits herewith verified translations of both priority Japanese Patent Applications, thereby perfecting priority of the present application under 35 U.S.C. § 119 and removing NOMURA et al. as a reference. It is therefore respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 102(e).

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §102, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.


SUMMARY AND CONCLUSION

Applicant thus respectfully submits that each and every pending claim in the present application is in condition for allowance, and respectfully requests withdrawal of the outstanding objection and rejection, and allowance of all pending claims in the present application.

Applicant notes that the amendment to the claim 1 is to be considered merely a clarifying amendment that is cosmetic in nature in order to render the terminology consistent throughout the claims, and is not intended to narrow the scope of the claims. Accordingly, this amendment should not be considered a decision by Applicants to narrow the claims in any way.

Should there be any questions regarding this paper or the present application, the Examiner is respectfully requested to contact the undersigned at the below-listed telephone number.

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February 10, 2005
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